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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,627	09/21/2001	Daniel R. Potter	005127.00062	4285
22909	7590	10/06/2003	EXAMINER	
BANNER & WITCOFF, LTD. 1001 G STREET, N.W. WASHINGTON, DC 20001-4597			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 10/06/2003

124

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/960,627

Applicant(s)

POTTER

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-70 is/are pending in the application.
- 4a) Of the above claim(s) 16-31, 35, 44-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 32-34, 36-43 and 58-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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**DETAILED ACTION**

***Election/Restrictions***

1. This application contains claims drawn to an invention nonelected with traverse in Paper No. 11. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. The election is hereby made **FINAL**.

2. Claims 16-31, 35 and 44-57 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No.11.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5, 14, 32-34 and 36-43, 58-59, 61-64 are rejected under 35 U.S.C. 102(b) as being anticipated by WO

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91/10376 (WO '376). WO '376 discloses all the limitations of the claims including the following: resilient sealed bladder 30, 22 for containing fluid (no fluid escapes and the bladder is not "breathing", i.e. allowing air to enter the bladder from outside the shoe upon lifting of the foot and exit the bladder and shoe upon placing the weight of the user's foot upon the bladder); the bladder having a sole portion 30 adapted to be received by an opening 38 in the sole assembly; the bladder adapted to be positioned generally horizontally underneath a portion of the wearer's foot (30 placed within 38); a foot portion 22 extending generally vertically from the sole portion (see Figure 4); the foot portion adapted to be positioned to a side edge of a wearer's foot (see Figure 1); the sole and foot portion adapted to be positioned at a metatarsal region of a wearer's foot (see Figure 1); the sole and foot portion forming an L-shaped bladder (see Figure 4); the foot portion in fluid communication and integral with the sole portion (see Figure 4) wherein compression on the sole portion increases fluid pressure in the foot portion (only place for fluid to move to if compressed in foot portion); the sole portion of the bladder is thicker than the foot portion (see Figure 4); the sole portion is generally rectangular shaped (as seen in Figure 4); the foot portion is generally trapezoidal shaped (see Figure s 1 and 4, from side,

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22 is trapezoidal in shape); the resilient bladder has a channel within it (that where fluid flows); the initial fluid pressure of the bladder is above ambient pressure (see page 5, lines 10-11, pressurizing the bladder with fluid, i.e. above ambient pressure); upper connected to sole assembly thereby defining a volume for receipt of user's foot (see Figure 1); compensating means is the bladders with the sole portion being underneath a wearer's foot and adjacent the lateral or medial side edge ; the bladder being sealed (see sealed portion noted above) with a sole and integral foot portion 22, 30; the foot portion of bladder positioned adjacent lateral or medial side edge of sole (see Figure 4); opening in sole 38; midsole having contour and sole portion having surface generally flush with midsole contour (see Figure 1 for midsole and outer sole); bladder has outer surface generally flush with the lateral or medial side of the midsole (see Figure 4 and 1, 34 fits 42 with 22 flush with outer surface of midsole); bladder has surface and article of footwear is adapted to visibly expose the surface to an exterior of the article of footwear (are which tongue covers); bladder has a surface portion that is at least translucent to allow for the interior to be visible from the exterior of the footwear (see page 2, line 25-page 3, line 8); the opening in the sole is adjacent the lateral or medial side edge (see Figure 4); the

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opening is positioned in the metatarsal region of the sole (see Figure 4); the foot portion of the bladder extends upwardly from the sole and has a top edge that tapers downward towards the front of the sole (See Figures 1 and 4); the sole portion of the bladder is thicker than the foot portion (see Figure 4); the foot portion 22 is located on the exterior of the upper (see Figure 1); the sole and foot portion are substantially perpendicular to each other (see Figures 1, 3, 4); the foot portion extends upwards from the sole portion (see Figures).

5. Claims 1, 4, 5, 14, 32-34, 36 and 38-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Grim 5,383,290. Grim '290 discloses all the limitations of the claims including the following: (see Figures 7 and 8) resilient sealed bladder 82, 86, 87, 88, 89 (although includes valve for inflow of air, bladder is sealed in that when valve is closed, no air is able to get in or out of bladder) for containing fluid; the bladder having a sole portion 82 adapted to be received by an opening (see Figure 7, opening is shown between insole and outsole) in the sole assembly; the bladder adapted to be positioned generally horizontally underneath a portion of the wearer's foot (see Figure 7); a foot portion 86, 87 extending generally vertically from the sole portion (see Figure 7); the foot

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portion adapted to be positioned to a side edge of a wearer's foot (see Figure 7); the sole and foot portion adapted to be positioned at a metatarsal region of a wearer's foot (see Figure 7); the sole and foot portion forming an L-shaped bladder (See Figure 7, also best shown in Figure 9); the foot portion in fluid communication and integral with the sole portion wherein compression on the sole portion increases fluid pressure in the foot portion (only place for fluid to move to if compressed in foot portion); the resilient bladder has a channel (that where fluid is located in the bladder); pressure in resilient bladder is above ambient (increased by pump); upper connected to sole assembly and defining volume for foot (see Figure 7); compensating means is the bladders with the sole portion being underneath a wearer's foot and adjacent the lateral or medial side edge ; the bladder being sealed (see sealed portion noted above) with a sole and integral foot portion; foot portion of bladder positioned adjacent the lateral or medial side edge (see Figure 7); foot bed of sole having medial and lateral side edges (where medial and lateral side edges of bladder sole portion 82 is placed within); foot portion of bladder extending upwardly at the lateral or medial side edge (see Figure 7); midsole having contour and sole portion has surface that is flush with the midsole contour (see Figure 7); midsole has a lateral and medial

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side and the bladder has an outer surface that is generally flush with the medial or lateral side (see Figure 7, but best shown in Figure 9); bladder has a surface and the article of footwear is adapted to visually expose the surface to an exterior of the article of footwear (through area where foot is placed within the shoe); the opening is adjacent the lateral or medial side edge (where tongue covers opening); the opening is positioned in a metatarsal region of the sole (see Figure 7 where tongue is located); the foot portion has a top edge that tapers downwardly toward the toe region (see center to front of 86 as placed in Figure 7).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 66-67 and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 91,10376 in view of Official Notice. WO '376 discloses all the limitations substantially as



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claimed including the following: an upper defining a void for receiving a foot of a wearer (see Figure 1); the upper having a medial and lateral side (see Figure 1); a sole assembly 12 secured to the upper; a sealed bladder 30, 22 that encloses a pressurized fluid; the bladder having a sole portion 30 and an integral foot portion 22 in fluid communication; the sole portion being at least partially encapsulated within the sole assembly and positioned underneath the void (see Figure 4); the foot portion extending upward from the sole portion and along at least one of the medial side and the lateral side of the upper (see Figures 1 and 4); the thickness of the sole portion is greater than the thickness of the foot portion (see Figure 4); the sole portion and the foot portion are substantially perpendicular to each other (see Figure 4); a volume of the foot portion increases upon compressing the sole portion (typical operation of a bladder. WO '376 does not disclose the sole assembly being made of a polymer foam material. Official Notice is taken that it is well known in the art to make sole out of polymer foam material such as polyurethane. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the sole of WO '376 out of a foam material such as polyurethane, to aid in cushioning the impact of the user's foot with the ground.

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8. Claims 2, 4, 6-13, 43, 60 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 40, 58 and 66 above in view of Allen et al. 5,313,717. The references as applied to claims 1, 40, 58 and 66 above disclose all the limitations of the claims except the sole portion of the bladder being thicker than the foot portion; the bladder having a channel for improving the flexibility and structural integrity of the bladder, and the limitations with respect to the recess in the top surface and the contacts. Allen et al. '717 teaches that a bladder used within a shoe sole can have a sole portion 34, 36 that is thicker than the foot portion 28 (made up of layer 36) to allow for better cushioning of the user's foot with the impact of the shoe to the ground. Allen et al. '717 also teaches that channels can be recessed in the top surface of the bladder to control flow of the fluid (channels defined by clefts 52) with the channels running perpendicular to the foot section (see Figure 3). The sole having a bottom surface with a contact (clefts 52) that connects the bottom surface to the channels. These clefts being oval in shape (see Figure 3) with the channels extending to the inside surface of the foot portion. These clefts allow for the bladder to flex (see col. 6, lines 47-53). Therefore, it would have

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been obvious, to one of ordinary skill in the art at the time the invention was made, to place clefts defining channels, as taught by Allen et al. '717 in the bladder of the references as applied to claims 1, 40, and 58 and 66 above to allow for better fluid control and flexibility of the bladder with respect to the natural flexion of the user's foot.

### ***Response to Arguments***

9. Applicant's arguments filed July 29, 2003 have been fully considered but they are not persuasive. Applicant argues that the ducts and sacs of the WO '376 reference are not integral since they are attached to each other after manufacture. While the ducts and sacs of the reference comprise several parts, they are rigidly secured together as a single unit; constituent parts are so combined as to constitute a unitary whole, which is "integral" within meaning of the claim; "integral" is not limited to a fabrication of parts from a single piece, but is inclusive of other means for maintaining parts fixed together as a single unit; moreover, use of one piece construction instead of reference structure is matter of obvious engineering choice. Applicant further argues that Grim allows ambient air to enter the bladder through the valve secured to the bladder and therefore the bladder is not sealed. This argument is not

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clearly understood. When the valve of the bladder is closed, the bladder is sealed, thereby not allowing any air to enter the bladder and meeting the claimed limitation.

10. At this time, the examiner would like to note that the last 2 pages of applicant's amendment appear to not have been received by the Office. Therefore, a response to any of the arguments on those pages is not included herewith. The claims, as noted in the rejections above, stand finally rejected.

#### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>



Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS  
October 6, 2003